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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,215	06/12/2000	Brian H. Silver	5297/133	5489

7590

12/16/2004

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EXAMINER

HAN, MARK K

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/592,215

Applicant(s)

SILVER ET AL.

Examiner

Mark K Han

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32 and 34-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32 and 34-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03 November 2004 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 34, 35, 37 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,838,946 to Schall.

Schall shows a double diaphragm pump that is capable of being used within a breastpump. Schall discloses that pump includes a first housing part 13, a second housing part 22, a first flexible diaphragm 15 integrally mounted over and within an opening that is formed by the first housing part 13, a second flexible diaphragm 24 integrally mounted over and within an opening that is formed by the second housing part 22, a first rigid hemispherical cap member 14 that is removably and sealingly mountable over the opening formed by housing part 13, and a second rigid hemispherical cap member 23 that is removably and sealingly mountable over the

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opening formed by second housing part 22. An expansible chamber 16 is formed between the first rigid hemispherical cap member 14 and the first flexible diaphragm 15 and another expansible chamber 25 is formed between the second rigid hemispherical cap member 23 and a second flexible diaphragm 24. See Figure 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 32, 36 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Schall in view of U.S. Patent No. 4,508,011 to Nolden.

Schall discloses the claimed invention except for a material to dampen noise and vibration.

Nolden discloses using a coating to dampen the noise and vibration of the interior of the housing.

See col. 2, lines 40-44. It would have been obvious to one of ordinary skill in the art to include the coating of Nolden in the invention of Williams as a means to reduce noise and vibration from the pump motor.

Response to Arguments

4. Applicant's arguments filed 03 November 2004 have been fully considered but they are not persuasive.

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The rejection under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,838,946 to Schall for claims 34, 35, 37 and 38 has been sustained. In p. 4, paragraph 4 of applicant's remarks, applicants assert that first housing part 13 and second housing part 22 of Schall do not form an interior space because Schall allegedly requires five parts to create the space. Without any descriptive elements defining such housing parts, the Examiner is left to interpret "housing part" according to ordinary and customary meanings. *Sunrace Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003); *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298, 67 USPQ2d 1132, 1136 (Fed. Cir. 2003). Here, the first and second housing parts cannot be limited solely to what Schall describes as elements 13 and 22, respectively. This may even include Schall's element 12, which may be divided in any way so that one part can belong to the "first housing part" and the other to the "second housing part." Additionally, an "interior" does not necessarily imply an enclosed space. For example, a cylinder, which is not enclosed at either end, definitely has an interior and exterior according to ordinary and customary meanings attributed by those of ordinary skill in the art. Therefore, Schall's first and second housing parts definitely form an interior space to contain pump mechanism components. With respect to applicants' arguments regarding diaphragms being integrally mounted with the housing parts, it is unclear how these arguments point out patentability of the claimed invention over the prior art. Applicants present an example that "integrally" would merely mean molding the diaphragm with the puller. Schall would share the same interpretation of that word. Here, Schall's diaphragms 15 and 24 seem to mold and take the shape of the first and second housing parts at the points where they are attached. Rejection of the aforementioned claims under 35 U.S.C. §102(b) is hereby sustained.

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In response to applicant's argument that U.S. Patent No. 4,508,011 to Nolden is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Nolden uses noise reduction materials to dampen the noise of the machine. The functionality of the noise reduction materials is not destroyed by including it in the invention of Schall. Nolden doesn't seem to suggest that the noise is coming from the rippling, as Applicants' suggest. See col. 1, lines 52-54. The noise is coming from the machine itself. Schall does not suggest the exclusion of noise reducing material. By combining the two references, the claimed invention may be rendered as obvious. Rejection of claims 32, 36 and 39 under 35 U.S.C. §103(a) as being unpatentable over Schall in view of Nolden is hereby maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark K Han whose telephone number is 571-272-4958. The examiner can normally be reached on Monday to Friday, 9 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mark Han
Patent Examiner
Art Unit 3763

mkh
December 10, 2004



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